REMARKS

Claims 1-4, 6-8, 10-17, 19 and 20 are pending.

In the office action mailed February 5, 2009, the claims were rejected under 35 U.S.C. §101. Paraphrased, the Examiner stated that the claims are directed to non-statutory subject matter because the claimed methods are not (1) tied to another statutory class (such as a particular apparatus) nor does the method (2) transform underlying subject matter (such as an article or materials) to a different state or thing. The Examiner alluded to U.S. Supreme Court and Federal Circuit case law as requiring statutory subject matter to be tied to another statutory class or transform an article or materials. In addition to the subject matter rejection, claims 1-4, 6-8, 10-17, 19 and 20 were also rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 7,359,920 to Rybicki et al. in view of U.S. pre-grant publication 2002/0059281 by Watanabe et al.

Referring now to the claim rejections that were made under §101, the Applicant respectfully disagrees with the Examiner's opinion that claims 1-14 and 18-20 are directed to non-statutory subject matter. The statutory subject matter "test" that the Examiner alluded to in the Office Action is actually two *different* tests that were articulated by the Court of Appeals for the Federal Circuit in the case of *In re Bilski* in the Court's decision that published on October 30, 2008.

On page 10 of the *In re Bilski* opinion as it was first published by the CAFC on its web site,[1] the Court said that, "A claimed process is surely patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." The Court thus provided two separate tests. Under *Bilski* any claimed method that passes *either* test recites statutory subject matter.

In this case, the claim 1 preamble recites that the claimed method is directed to a communication system comprised of a network part and a mobile node. The first limitation of

[1] The URL for the Federal Circuit's web site is www.cafc.uscourts.gov/dailylog.html. The In re Bilski opinion is still available on the Court's web site at www.cafc.uscourts.gov/opinions/07-1130.pdf.

claim 1 clearly and plainly recites that the claim requires the receipt of a synchronization initiation message *at a mobile node*. The second claim limitation requires forming hash values *at the mobile node*. The third claim limitation requires forming a group hash value, *at the mobile node*. The fourth claim limitation requires communicating hash values *from the mobile node to the network part*.

Claim 1 and all of the claims that depend from it are clearly and plainly directed to a particular apparatus, namely a communication system that includes a mobile part and a network part. The first of the two tests of patentable subject matter that were set out in *In re Bilski* and, which are stated in paragraph 1 of the Office Action, is clearly satisfied.

Independent method claim 15 recites statutory subject matter for the same reason that claim 1 does. Claims that depend from claim 15 therefore also recite statutory subject matter.

If the Examiner maintains the subject matter claim rejections under 35 U.S.C. §101, the Applicant preemptively but respectfully asks the Examiner to specify in detail, how and why the claims' recitation of method steps performed in a mobile node of a communications system, are *not* directed to a particular apparatus. Notwithstanding the impropriety of the Examiner's rejections under §101, the preamble of claim 1 has been superficially amended to recite that what is recited in claim 1 is a method for synchronizing copies of a database kept at a mobile device and in a network, to each other.

Referring now to the claim rejections that were made under §103, the independent claims have been amended to recite that databases in the mobile node and in the network part are comprised of text-formatted databases utilizing an Extensible Mark-Up Language (XML) format. Support for the claim amendments can be found in paragraph [0036] of the written description as it is published by the USPTO. No new matter has been added by the claim amendments.

Paragraph [0036] of the application as published by the U.S. Patent and Trademark Office (U.S. Pre-grant publ. 2006/0080427) states in pertinent part that, "*the …databases are of a text format, here an extensible mark-up language (XML) format*." (Emphasis added.)

XML is well-known to those of ordinary skill to be a condensed form of the Standard Generalized Mark-up Language or SGML. Among other things, XML facilitates the creation of documents that can be used on different computing platforms and that retain their formatting, indexing from one computer to the next. XML documents can also be used to store information that other sorts of documents or databases are unable to do. Among other things, the apparatus and method recited in the amended claims enable the network synchronization of databases stored in mobile devices with different architectures, including devices made by different manufacturers.

The XML databases recited in claims 1 and 15 are, among other things, platform-independent. By virtue of the inherent characteristics of XML, the structure of the databases recited in claims 1 and 15 are more flexible than would be possible using the databases in either Rybicki or Watanabe. The claimed databases are also platform independent.

The pending claims pass the first test of subject matter set forth in *In re Bilski*. Neither prior art reference cited by the Examiner discloses or suggests the use of XML-format records as the amended claims require. The pending claims are therefore in condition for allowance under 35 U.S.C. §101, §102 and §103. Reconsideration of the pending claims is therefore respectfully requested. Such early action is earnestly solicited.

Respectfully submitted,

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